

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD C. JOHNSON
and
JEFFREY SPILFOGEL

Appeal No. 2004-0203
Application 09/780,320

ON BRIEF

Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 1.197(b) (amended Dec. 1, 1997), appellants have submitted a Request for Reconsideration¹ (hereafter "Request") dated Mar. 3, 2004, Paper

¹A Request for Reconsideration is now denominated as a Request for Rehearing. See 37 CFR § 1.197(b), amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997).

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No. 19, of our Decision dated Feb. 19, 2004, Paper No. 18, affirming the rejection of claim 1 under 35 U.S.C. § 102(b) over Hyams (Decision, Paper No. 18, page 2).

Appellants request rehearing based on two issues. First, appellants request reconsideration of the following statement at page 5 of the Decision (Request, page 2):

However, the claim on appeal as construed above is directed to a finished product while the intermediate process limitations have not been shown by appellants to change or differentiate the claimed product from the finished product of Hyams.

Appellants argue that the "observation" that the unfolded edges of the product claim are not differentiated from the folded edges of Hyams is not accurate, and is a significant difference since the latter produces "bulk" which is a source of discomfort, and the former does not (*Id.*).

Appellants' argument is not persuasive. We note that the "observation" quoted from page 5 of the Decision is based on our claim construction, including consideration of the product-by-process format of the claim, which construction appellants have not contested. Contrary to their argument, appellants have not established that Hyams is directed to the "conventional" folded edges of the acknowledged prior art (as shown in appellants' Figure 2). The evidence of record shows that Hyams discloses

that a problem in known pads and straps is the presence of seams, and Hyams teaches a solution by making a brassiere shoulder strap "free of seams" (see Hyams, col. 1, ll. 42-45; col. 1, l. 67-col. 2, l. 2; col. 2, ll. 13-14; and col. 3, ll. 35-36). Appellants have submitted that "seamless" construction in brassiere shoulder straps means formation of the straps "without inturned edges" (Brief, page 2). Hyams further teaches fusing to bond the layers of the strap together (col. 4, l. 67-col. 5, l. 4; see Figs. 1A, 1B and 2). Therefore, on this record, there is no evidence to support appellants' argument that Hyams is directed to "folded edges" strap construction. Additionally, we note that appellants have not submitted any evidence that the *claimed* finished product differs from the finished product disclosed by Hyams.

Second, appellants argue that, in the alternative, the Board Decision at page 5 includes an "explicit statement" that appellants "may be allowed to rephrase the content of the product claim as a process claim" (Request, page 3). However, appellants have not identified, and we do not find, any explicit or implicit statement in our Decision that appellants should be "allowed to rephrase the content of the product claim as a process claim." At this stage of the prosecution, we find no reason for allowing appellants to amend the claim.

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For the foregoing reasons and those stated in the Decision, we have considered appellants' Request but do not find any argument convincing us of error in law or fact. Accordingly, appellants' Request for Rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

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| CHUNG K. PAK |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| THOMAS A. WALTZ |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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| PETER F. KRATZ |) | |
| Administrative Patent Judge |) | |

TAW:svt

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